

**REMARKS**

The Office Action of April 19, 2005, has been received and considered. Claims 119 and 135 have been amended, and claim 139 canceled. Reconsideration of the application as amended is respectfully requested.

Applicant acknowledges that a supplemental reissue declaration is needed, but requests that this requirement be held in abeyance until agreement is reached in regard to all the claims.

Claim 135 has been amended to include the material of claim 139. Accordingly, it is believed that claims 135-137 are now considered allowable.

The only remaining rejected independent claim is claim 119. This claim has been amended to better distinguish the claim from the combination of references proposed by the examiner.

Jones '496 is designed to mount an adapter to a lip. In accordance with this arrangement, the lip includes a through-hole to receive a C-clamp 26 that grips the rear end 24, 25 of each leg of the adapter, and a wedge member 28. The wedge member has an arcuate wall 30 that sets against a curved wall 29 of C-clamp 26. The wedge is driven along the path defined by curved wall 29 by a vertically positioned bolt 33. The bolt is secured to the C-clamp with a nut 35 at the bottom of the C-clamp. The C-clamp, bolt and wedge are placed loosely within the through-hole in the lip and arranged with the C-clamp being over the ends 24, 25 of the adapter. Once properly positioned, the bolt is turned to drive the wedge downward and forward along curved surface 29 to tightly grip and hold the adapter to the lip. Without tightening of bolt 33, the adapter cannot be mounted to the lip.

Jones '214 is designed to mount a shroud to a lip. In accordance with this patent, the shroud includes a longitudinal slot that receives a boss fixed to the lip. A lock is placed between the rear wall of the boss and a bearing face of the wear member to prevent release of the wear member from the lip. In contrast to Jones '496, there is no need to tighten the assembly to hold it into place. Simply placing the lock into the assembly holds the wear member to the lip.

Applicants submit that it would not have been obvious to one of ordinary skill in the art to change Jones '214 so as to use the lock arrangement taught by Jones '496, which requires tightening of the bolt to work, instead of the lock used in Jones '214, which requires no additional steps to work. Jones '214 states that "the most desirable designs are those that are mechanically attached and easy to install and remove" (col. 5, lines 59-61). Jones '214 further uses the disclosed design for the purpose of avoiding "the need for extensive locks" (col. 4, lines 60-62). A modification that is contrary to the intentions of the primary reference should not be considered obvious.

The examiner notes that "an extensive lock" is not "necessarily a 'complex lock' similar to the lock in the '496 patent." However, prior art noted in Jones '214 uses a lock that is similar to the lock in the '496 patent. US Patent No. 3,621,594 (col. 1, lines 15-20; the first patent cited in the background of Jones '214) relies upon a C-shaped spool and wedge to secure adapters to the lip. Jones '214 is seeking to improve on the prior art cited in the "Background" section. We submit that the reference to "extensive locks" in the Jones '214 patent is a reference to the more complex locks used in the prior art specifically mentioned in Jones '214. Hence, Applicants submit that the proposed modification of Jones '214 is not

in keeping with one of the disclosed benefits of the device.

In addition, even if the combination of the references is proper, the claimed invention would still not be taught to one of ordinary skill in the art.

First, claim 119 recites that the lock is generally aligned with the slot and maintained to one side of the lip. In Jones '496, the lock arrangement only works because of the through-hole in the lip. Turning of the bolt requires an anchor to drive the wedge along curved wall 29. The needed anchor is achieved by placing the nut 35 in opening 38 and securing the C-clamp arms over the rear ends 24, 25 of the legs. This tightening arrangement will only function therefore if there is a through-hole in the lip.

The examiner argues that it is not necessary for the parts of the secondary reference to be physically incorporated into the primary reference. While this proposition is true, this is not Applicants argument. Quite clearly, the lock arrangement of Jones '496 will not physically fit into the assembly of Jones '214 without modification. While we do not accept that the combination is obvious, Applicants are not arguing for the allowance of the claim on the basis that the lock assembly will not physically fit into Jones '214. Rather, any rejection must be based on a consideration of the teachings of the secondary reference without the benefit of the teachings of the present application.

Accordingly, Jones '496 teaches the use of a lock which is capable of being tightened. The only teaching in Jones '496 is that such a lock is usable in a through-hole in the lip. If Jones '214 is to be modified to use the teachings of Jones '496 to achieve a tightening capability, the teaching would be to use a through-hole in the lip. There is no suggestion to design a new lock with a tightening capability that is generally aligned with the slot and is

maintained to a side of the lip. This teaching is only found in the present invention.

Moreover, claim 119 now recites a lock with a body and an adjustment member, wherein (i) the body includes an axial hole that is generally parallel to the slot in the leg and (ii) the adjustment member is movably secured in the axial hole for axial movement relative to the body. These claim limitations provide details of the preferred construction of the present lock, and further distinguish the claim from the proposed combination of Jones '214 and Jones '496. There is nothing in either of the relied upon patents that suggests the use of a lock comprising a body and an adjustment member, wherein the adjustment member is movably secured within an axial hole in the body. Hence, it would not have been obvious to one of ordinary skill in the art to have created a lock as claimed.

Support for the amendments to claim 119 can be found in col. 3, lines 54-56, col. 4, lines 46-49, col. 5, lines 40-49 and 66-67, col. 6, lines 1-7, and Figures 1-2 and 14-17. Support for the amendment of claim 135 can be found in col. 5, lines 9-11, and Figures 2 and 10.

For all of the above-discussed reasons, Applicant submits that claims 119-124 are allowable along with the remaining claims. A notice to this effect is earnestly solicited.

Respectfully submitted,

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### APPENDIX

Below are shown the form of the amended claims as compared to their form prior to the amendment. The new material has been underlined and the deleted material struck out.

119. (Twice Amended) A wear assembly for attachment along a lip of an excavator comprising:

a boss fixed to the lip and having a rear wall;

a wear member having (i) a forwardly projecting working end, (ii) a rearwardly extending leg having an inner side adapted to face the lip, a rear wall generally transverse to the inner side, and a longitudinal slot open in the inner side and the rear wall of the leg to receive the boss and thereby provide support to the position of the wear member on the lip, and (iii) ~~an opening~~ a forwardly facing bearing surface; and

~~a lock received into the opening placed in general alignment with the slot and maintained to one side of the lip for engagement with the rear wall of the boss and the between bearing surface of surfaces on the boss and the wear member to retain the wear member to the lip, the lock including a body having an axial hole extending generally parallel to the extension of the slot, and an adjustment member movably secured to in the axial hole of the body such that axial movement of the adjustment member in the axial hole relative to the body expands the lock between the bearing surfaces so as to press against the rear wall of the boss and the bearing surface of the wear member and thereby moves move the wear member rearward to thereby tighten the mounting of the wear member on the lip.~~

135. (Twice Amended) A wear member for mounting on a front lip of an excavator having a fixed boss, the wear member comprising (i) a forwardly projecting working end, (ii) a rearwardly extending leg having an inner side to face the lip, a rear wall generally transverse to the inner side, and a longitudinal slot open in the inner side and the rear wall of the leg to receive the boss and thereby provide support to the position of the wear member on the lip, the slot including a rearwardly-facing bearing surface at a front end thereof and extending out of the slot for abutting against a front wall of the boss in face-to-face contact for resisting rearwardly directed loading on the wear member during use, and (iii) a lock receiving opening extending through the wear member and having a first forwardly-facing bearing surface extending generally transverse to the lip to contact the lock.